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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,568	12/18/2000	Frederik M. DeWolf	T7900-10	6323

35465 7590 03/07/2007  
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EXAMINER
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PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/740,568

Applicant(s)

DEWOLF ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-61, 64-71, 74, 76-79, and 81-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Continuation of Disposition of Claims:** Claims pending in the application are 1-5,7,9,13,14,17-19,21,22,24,25,27-29,31-33,35,37,36,37,37,37,38,42,43,46-48,50-52,54-61,64-71,74,76-79 and 81-89.

### **DETAILED ACTION**

1. This communication is in response to amendment filed 11/28/06.

#### ***Response to Amendment***

2. Claims 1, 21, 28, 52, 55, and 85 have been amended and claim 87 has been cancelled. Claims 1-5, 7, 9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-61, 64-71, 74, 76-79, and 81-89 are pending.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejections.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 28, 29, 31-33, 35, 37, 38, 42 and 43 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites, "Wherein the data recorded comprises data related to one or more transactions pertaining to the asset."

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The aforementioned claims are rendered indefinite because there is no antecedent basis for limitation "the data recorded". It is interpreted to read, "the information recorded".

### **Claim Rejections - 35 USC § 101**

5. Claims 1-5, 7,9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35.37-38, 42-43, 46-48, 50-52, 54-61, 64-71, 74, 76-79, and 81-89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link,

[http://www.uspto.gov/web/offices/pac/compexam/interim\\_guide\\_subj\\_matter\\_eligibility.html](http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html))

for details), a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

Since, the physical transformation test is not relevant to the instant claims, the proper test to determine whether the claimed invention satisfies the "practical application" is whether the claimed invention produces a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable

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exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

Exemplary analysis of claim 1 is provided which applies to all independent claims, including the system/product claims 52, 71, 85, 87 and 89.

Claim 1 recites a method for recording and managing information related to assets in an electronic asset registry. It is noted that the asset may be in the form of a digital object. The claimed invention assigns a unique identifier to the asset, records information related to the asset in an electronic asset registry and categorizes the information into multiple attributes. The claimed invention manages read and write privileges to the electronic asset registry for a plurality for entities and provides read and write access to asset attributes to the entities.

The amended claims provides access to asset attributes to entities who have interest in the asset. This limitation suggests that the claimed invention provides capability to the entities so they can access the asset attributes. However, claims do not positively recite that the entities access the asset attributes which would be deemed a tangible result of the claimed invention.

However, in the present form, the claimed invention does not produce a tangible result. Managing read and write privileges to the asset registry for a plurality of entities and “providing access to asset attributes” to the entities for read and write capabilities does not produce a real world result because the claimed invention merely provides capabilities to the entities to read or write attributes of an asset registry which has a categorized information pertaining to the assets into the attributes. Nothing tangible happens until an entity actually accesses the registry, then reads or writes to the specific attributes thereby affecting the status of the assets. The recitation

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of “managing” of and “providing access to” the read and write privileges is too broad to be interpreted as process or processes that actually alter the state of the assets, a real world or tangible act as the applicant suggests. Managing of read and write privileges is interpreted as allocating privileges by a programmer or database manager and providing access is interpreted as having capabilities so individuals *can* read and write the specific attributes. The examiner’s assertion is that until the allocated read and write privileges are accessed by the respective entities to affects the change in status of the asset nothing tangible happens.

Therefore, it is concluded that the claimed invention is not meet the requirements of being “useful, concrete and tangible” and is directed to a non-statutory subject matter.

The foregoing analysis applies to all system and apparatus claims and dependent claims.

6. Claims 52-54, 71-74, 79, 81-84 and 86 are additionally rejected as being nonfunctional or nonfunctional descriptive material.

7. Independent claim 52 recites a system for recording information related to an asset and providing access to the information to interested parties. The claim comprises limitations which, viewed in light of the specification are program codes (interfaces) and database (asset registry) or computer executable codes. However, the computer codes or database themselves are not functional until a computer or a processor is connected to the asset registry in association with the interfaces. Therefore, claims 52-61, 71-74 and 79, 81-84 in the present form are treated as nonfunctional system, which cannot produce “useful, concrete and tangible result”. Note that the wherein phrase is not given patentable weight because it does not alter the structure the claimed system.

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Claims 71 and 74 are product claims directed to “an electronic asset record” resulting from method of claim 1. An electronic record is interpreted as nonfunctional descriptive material. The applicant states that the record is on computer readable media, and “it is clear that record is functional and can function with a computer to affect a practical result”. The examiner disagrees with this interpretation because, the electronic record, generated from a process of claim 1 is not computer executable code but mere collection of data which is nonfunctional descriptive material, which even if recorded on a computer readable medium remains nonfunctional (i.e. not capable of producing concrete, tangible and useful result). See MPEP § 2106 (IV)(B)(1). Claim 71 recites “allowing said processor to read write access privileges” which is treated as intended use of the asset record. Such limitation is not afforded any patentable weight. See MPEP 2111.04.

8. Claim 87 is directed to a data structure recorded on a computer readable medium. The data structure is interpreted as nonfunctional descriptive material. Further details are provided in claim 71 analyses.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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1. Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-, 64-71, 74, 76-79 and 81-85, 87, 88 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham et al. (US 5,446,903) (hereafter "Abraham").

Abraham teaches a method for recording information related to assets (col. 2 L 5-25), the method comprising:

identifying the asset to be entered into an asset registry;

assigning a unique identifier to the asset;

(independent projects, inherently each project is identified by unique identifier, for the purpose of various management objectives such as tracking progress of the projects, personnel assignment, cost allocation etc.)

recording the information related to the asset in the asset registry, wherein the information is associated with the unique identifier;

(refer to col. 10 L 18-39, information related to a project is recorded as "predetermined groups of data elements also referred to as "data categories")

categorizing the information related the asset into multiple attributes;

(refer to "data categories" as discussed above)

managing read and write privileges to the asset registry for various entities;

(col. 10 L 61- col. 11 L 17, .." the access which is granted may be read only or read/write access, and the access which is denied may also be write access or read/write access.)

providing access the attributes to the various entities that have an interest in the asset, wherein an entity having write privileges for a first attribute of the asset can write

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data related to a change in the first attribute of the asset the asset registry, and an entity having read privileges for a second attribute of asset can read data related to the second attribute.

((col. 10 L 61- col. 11 L 17, ..“ the access which is granted may be read only or read/write access, and the access which is denied may also be write access or read/write access.)

Abraham does not expressly show the assigning, recording, categorizing, managing and providing access pertain to assets in a asset registry .

However these differences are only found in the nonfunctional descriptive material (asset and asset registry) and are not functionally involved in the steps recited. In other words the process of assigning, recording, categorizing, managing and providing access would be performed the same regardless of the type of data whether the data pertains to assets or not. Furthermore, there is no manipulative difference in the process involved based upon where the information is recorded, categorized or managed. In this regard the term “asset registry” is not distinguished from any database or data repository.

The examiner need not give patentable weight to descriptive material absent a new and non-obvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004).

Claim 1 recites the terms “asset”, “asset registry” and “electronic asset registry” as nonfunctional descriptive material. These limitations have been carefully reviewed to determine whether they should be given patentable weight.

The descriptive material referenced above is non-functional and is not given patentable weight because there is no non-obvious functional relationship between the descriptive material and the manipulative step of recording, categorizing, managing read and write privileges and providing access. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the requisite process steps described in Abraham to any type nonfunctional data because such data does not functionally relate to the steps in the method

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claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 2-51, 61,62 : The method of claim 1, wherein the information being recorded for an entire life cycle of the asset, portion of a life cycle of the asset, the asset (project) includes multiple component (see col. 6 L 1+ “progresses through series of steps” etc. which implies life cycle of a project (or asset).).

Many features recited in the aforementioned subject claims are rendered obvious as per (“non-functional limitation”) analysis of claim 1.

For example, claim 9 recites: wherein the information related to the asset includes data identifying a manufacturer of the asset. As noted in claim analysis the process steps must be dependent upon the descriptive limitation “asset”. However, none of the process steps are altered based upon the specifics of the asset. The manipulative steps assigning, recoding, categorizing, managing and providing access are not altered whether the assets include certain type of data such as that recited in claim 9.

As per claims 52-54 Abraham discloses a system for recording information related to asset and providing access to the information to interested parties throughout cycle of the asset as per discussion of claims 1-51.

Abraham inherently disclose a network providing a link between the plurality of entities and asset registry (refer to col. 8 L 8-25, which recites in part “ ..It will be understood ..computing environment 13 may operate across multiple computer platforms”).

Claim 53: asset registry includes one or more databases (see Figure 4-8).

Claims 54: Abraham fails to teach that the network is the Internet.

Official Notice is taken that providing information concerning asset management over the

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Internet is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the system of Abraham such that the users (entities) may access the asset registry (OO computing environment) over the Internet, since the benefits of providing information over the Internet such as wide and unconstrained access to users are well known.

Claim 55. As per corresponding method claim 1, Abraham discloses a system for recording information related to an asset and providing access to the information to interested entities.

(refer to claim 1 analysis)

Claim 56. The system claim 55, wherein the means for recoding information records information related to any change status of the asset. (see col. 6 L 61- col. 7 L 35)

Claim 57. The system of claim 55, wherein the means for recording information records information related to transactions that have an affect on the asset.

(see col. 6 L 61- col. 7 L 35)

Claim 58. The system of claim 57, wherein the means for recording information records documents related to the transactions.

(see col. 6 L 61- col. 7 L 35, col. 8 L 51+ engineering change control management system )

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Claim 59. The system of claim 57, wherein the means for recording information records entities participating in the transactions.

(see col. 7 L 15-35, each user of the system associated with one or more security groups..security category)

Claim 60. The system of claim 55, wherein the means recoding information records information related to the entities having interest in the asset.

(see col. 7 L 15-35, each user of the system associated with one or more security groups..security category)

Claim 61. wherein the means for providing access to the various attributes of the asset includes means for authenticating the entity desiring access.

(see col. 7 L 15-35 each security group is given access (read/write, read only or one)..)

Claims 52-61, 71-74 and 81-84 are additionally rejected as being nonfunctional or nonfunctional descriptive material.

1. Claim 52 recites a system for recording information related to an asset and providing access to the information to interested parties. The claim comprises limitations which, viewed in light of the specification are program codes (interfaces) and database (asset registry) or computer executable codes. However, the computer codes or database themselves are not functional until a computer or a processor is connected to the asset registry in association with the interfaces. Therefore, claims 52, 54, 79, 81-84 and 86 in

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the present form are treated as nonfunctional system, which cannot produce “useful, concrete and tangible result”.

2. Claims 71 and 74 are product claims directed to “an electronic asset record” resulting from method of claim 1. An electronic record is interpreted as nonfunctional descriptive material. The applicant states that the record is on computer readable media, and “it is clear that record is functional and can function with a computer to affect a practical result”. The examiner disagrees with this interpretation because, the electronic record, generated from a process of claim 1 is not computer executable code but mere collection of data which is nonfunctional descriptive material, which even if recorded on a computer readable medium remains nonfunctional (i.e. not capable of producing concrete, tangible and useful result). See MPEP § 2106 (IV)(B)(1). Claim 71 recites “allowing said processor to read write access privileges” which is treated as intended use of the asset record. Such limitation is not afforded any patentable weight. See MPEP 2111.04.
3. Claim 87 is directed to a data structure recorded on a computer readable medium. The data structure is interpreted as nonfunctional descriptive material. Further details are provided in claim 71 analyses.

### ***Conclusion***

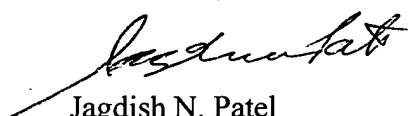
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

2/18/07